

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JASON KINGDON, TONY JAMES WICKS, ANNOOP SINGH MANGAT,
KONRAD SIMEON FELDMAN, and JOHN CHRISTOPHER TAYLOR

Appeal No. 2002-0098
Application No. 09/064,290

HEARD: January 16, 2003

Before BARRETT, DIXON, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-23, which are all the claims in the application.

We reverse.

BACKGROUND

The invention is directed to a system and method for auditing and accounting electronic value payment. Claim 1 is reproduced below.

1. A system for monitoring the flow of value through a population of users to detect fraud, comprising

means for assigning blocks of electronic value to users, the blocks each having a predetermined identity tag and being divisible into sub-blocks, each sub-block having the same predetermined identity tag; and

means for monitoring identity tags used in transactions and for detecting fraudulent transactions by associating said identity tags used in transactions with said predetermined identity tags.

Claims 1-23 stand rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is held to not enable one skilled in the art to make and/or use the invention.

We refer to the Final Rejection (Paper No. 10) and the Examiner's Answer (Paper No. 18) for a statement of the examiner's position and to the Brief¹ (Paper No. 17) for appellants' position with respect to the claims which stand rejected.

OPINION

Before turning to the merits of the instant rejection of claims 1-23 under 35 U.S.C. § 112, first paragraph, we briefly review the requirements of the statute with respect to providing an enabling disclosure.

¹ Appellants filed an earlier brief (Paper No. 15) that the examiner held to lack compliance with 37 CFR § 1.192(c)(7).

The first paragraph of 35 U.S.C. § 112 requires, *inter alia*, that the specification of a patent enable any person skilled in the art to which it pertains to make and use the claimed invention. Although the statute does not say so, enablement requires that the specification teach those in the art to make and use the invention without ‘undue experimentation.’ In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). That some experimentation may be required is not fatal; the issue is whether the amount of experimentation required is ‘undue.’ Id. at 736-37, 8 USPQ2d at 1404.

In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991).

The question is whether the disclosure is sufficient to enable those skilled in the art to practice the claimed invention; the specification need not disclose what is well known in the art. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984) (citing In re Myers, 410 F.2d 420, 161 USPQ 668 (CCPA 1969)). “A patent need not teach, and preferably omits, what is well known in the art.” Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1534, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987). “Not every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be.” In re Gay, 309 F.2d 769, 774, 135 USPQ 311, 316 (CCPA 1962).

The examiner bears the initial burden of setting forth a reasonable explanation as to why the scope of protection provided by the claims is thought to be not adequately enabled by the description of the invention provided in the specification. If that burden is met, the burden then shifts to the applicant to provide proof that the specification is

indeed enabling. In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

In the instant case, the examiner alleges that the disclosure fails to adequately define how the “blocks” and “sub-blocks” of electronic value are actually transferred between a “source” and one or more “users,” or between a “payer” and a “payee,” so as to achieve the “asserted advantages of the invention....” (Answer at 3.) The examiner finds it unclear how the claimed elements provide at least the “asserted advantages” listed at page 4 of the Answer. The “advantages,” however, are identified in the written description and Abstract of the disclosure, rather than in the claims before us.

Appellants respond to the rejection by, inter alia, countering that the examiner has failed to meet the initial burden in setting out a case for lack of enablement. (Brief at 7-8.) Appellants submit that a focus on “asserted advantages,” rather than on the claimed subject matter, is improper in a determination as to whether a disclosure is enabling under 35 U.S.C. § 112, first paragraph. (Brief at 8.)

While “asserted advantages” of an invention may be highly relevant in, for example, an obviousness inquiry under 35 U.S.C. § 103, we know of no legal principle which requires that unclaimed features or unclaimed “advantages” be enabled by a disclosure. Rather, the enablement inquiry under 35 U.S.C. § 112, first paragraph is to ascertain whether the disclosure enables one skilled in the art to make and use “the invention” -- i.e., the subject matter set forth by the claims -- without undue experimentation.

Moreover, the examiner cites no authority for the position with regard to enablement of unclaimed “advantages.” The examiner appears to retreat somewhat in the Answer’s arguments responsive to the Brief, by focusing on an asserted lack of concrete teachings in the specification or drawings for carrying out the claimed invention. (Answer at 9-12.)

“Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations.” In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The factors to be considered in determining whether a disclosure would require undue experimentation include:

(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Wands, 858 F.2d at 737, 8 USPQ2d at 1404.

The alleged absence of specific embodiments illustrating the invention is thus but one of the factors to be considered in whether undue experimentation may be required. In regard to another relevant consideration, we note that the level of predictability in the mechanical and electrical arts is recognized as being relatively high. See, e.g., In re Hogan, 559 F.2d 595, 606, 194 USPQ 527, 537-38 (CCPA 1977) (taking notice of the high level of predictability in mechanical or electrical environments

and the lower level of predictability expected in chemical reactions and physiological activity).

We have carefully considered the examiner's concerns as set forth in the Answer. However, we conclude that appellants' arguments set out at pages 13 through 21 of the Brief convincingly demonstrate that the examiner has not met the initial burden in showing that undue experimentation would be required.

We find at least two "specific embodiments" described by the disclosure. The drawings and the written description at pages 15 to 20 describe one embodiment that manipulates binary bits on an electronic payment device (EPD), which may be in the form of a telephone payment card (further in view of the background of the invention described at pages 3 through 5 of the specification). A second embodiment using a "tag map sort specifier" is described at page 20, line 6 et seq. of the written description. See In re Gay at 774, 135 USPQ at 316 (observing that "specific" is a somewhat indefinite term of degree and it is not necessary that an applicant be more specific than is required by the written description and enablement portions of section 112).

A description of the details of implementing the invention is not required if the artisan would know how to do so, using equipment and techniques within the level of skill in the art. Cf. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 941, 15 USPQ2d 1321, 1329 (Fed. Cir 1990) ("The claimed invention...is not in the details of the program writing, but in the apparatus and method whose patentability is based on the claimed combination of components or steps.") Although the precise means and

method for implementing the invention may not be described in the disclosure, there has been no showing that the artisan would not be able to fill in the gaps using knowledge common in the art. For example, it is not necessary that any particular wireless link or electrical connection be described (cf. Answer at 3) if the artisan is led to infer that wireless links or electrical connections in existence at the time of invention may be utilized.

To the extent the rejection of claims 1-14 and 16 may be based on an alleged lack of disclosed structures corresponding to the “means plus function” elements of the claims, we note that the issue of lack of corresponding structure is a consideration under 35 U.S.C. § 112, second paragraph, rather than the first paragraph of the statute. See, e.g., Atmel Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 53 USPQ2d 1225 (Fed. Cir. 1999); In re Dossel, 115 F.3d 942, 42 USPQ2d 1881 (Fed. Cir. 1997). A rejection based on alleged lack of disclosed structures corresponding to “means plus function” claim elements, drafted as permitted by 35 U.S.C. § 112, sixth paragraph, is thus not before us.

In any event, corresponding structure may be inferred from functions set out in the claims. See Dossel at 946-47, 42 USPQ2d at 1885 (determining that a unit which receives digital data, performs complex mathematical computations and outputs the results to a display must be implemented by or on a general or special purpose computer). The instant disclosure describes how electronic value may be stored in memory devices contained in an EPD (e.g., spec. at 5, ll. 16-27). Further, the

specification in the “Background” section describes computers, both special purpose (e.g., point-of-sale devices) and general purpose (e.g., computers for financial auditing) that would lead the artisan to infer that the claimed “means for assigning,” “means for monitoring,” and “means for detecting” refer to computers programmed to perform the claimed functions.

Since we agree with appellants that a prima facie case for lack of enablement has not been set forth on this record, we find consideration of the declaration attached to the Brief unnecessary. We do not sustain the rejection of claims 1-23 under 35 U.S.C. § 112, first paragraph.

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CONCLUSION

The rejection of claims 1-23 is under 35 U.S.C. § 112, first paragraph is reversed.

REVERSED

LEE E. BARRETT
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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